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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/537,405	07/28/2005	Masaharu Nagao	09857/0202953-US0	8474

7278 7590 03/30/2009

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EXAMINER	
KRAUSE, ANDREW E	
ART UNIT	**PAPER NUMBER**
1794	

MAIL DATE	DELIVERY MODE
03/30/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/537,405	NAGAO ET AL.	
	Examiner	Art Unit	
	ANDREW KRAUSE	1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *3,5,6,8,9 and 11* is/are pending in the application.

4a) Of the above claim(s) *1 and 2* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) *3,5,6,8,9 and 11* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *12/30/08*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. This application contains claims 1-2 drawn to an invention nonelected with traverse in the reply filed on 9/11/08. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Response to Amendment

2. The amendment to claim 3 is successful in overcoming the rejections under 35 U.S.C. 112, second paragraph as well as the claim objections.

3. The amendment to claim 3 is successful in overcoming the rejections of claims 3,5,6,8,9 and 11 under 35 U.S.C 102(b).

4. The new grounds of rejection present in this office action have been necessitated by the amendment to claim 3.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claim 3, 5, 6, 8, 9, and 11 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains

subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. There is no support in the specification for the new limitation providing that the hardness of the granulated flavor is obtained by using particles having a particle size of 105 microns-2 mm, wherein the proportion of the particles having that particle size is 85% or more by weight.

Claim Rejections - 35 USC § 103

7. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

8. Claims 3,5,6,8,9,11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Benczedi et al(USPGPUB # 2001/0036503 A1).

9. Regarding claim 3, Benczedi discloses a granulated flavor for use in foods and beverages containing: a carrier selected from the group consisting of hydrophilic proteins, maltodextrin (example 1), starches, modified starches, hydrophilic polysaccharides, partially hydrolyzed proteins, partially decomposed starches and saccharides, wherein the granulated flavor has a moisture content of 6% (example 1).

10. Benczedi discloses the granulated flavor comprises particles is with a diameter of 0.7mm (example 1) and that the length of the particles is adjustable (0051-0053).

11. Benczedi does not explicitly disclose that the granulated flavor has a particle size of 105 μm-2mm, wherein the proportion of the particles having that particle size is 85% or more by weight.

12. However, it would have been obvious to one having ordinary skill in the art at the time of the invention to adjust the particle size and proportion of particles having that size for the intended application, since it has been held that discovering the optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

13. As a result of having the same composition and particle size as instantly claimed, the product formed by Benczedi will intrinsically have hardness in the claimed range.

14. Regarding claims **6 and 9**, Benczedi teaches the product of claim 3 as rejected above. Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985), MPEP 2113. Further, "although produced by a different process, the burden shifts to applicant to come forward with evidence establishing an unobvious difference between the claimed product and the prior art product", *In re Marosi*, 710 F.2d 798, 802, 218 USPQ 289, 292 (Fed. Cir.1983). See MPEP 2113.

15. Regarding claims **5, 8, and 11**, Benczedi discloses that the invention the flavor of claims **3,6, or 9** is for incorporation into processed foods, cooked products, or baked goods (paragraph 2).

Response to Arguments

16. Applicant's arguments filed 12/30/08 have been fully considered but they are not persuasive.

17. Applicant has added the limitations of cancelled claims 4, 7, and 10 to the independent claim 3 in attempt to traverse the rejection. Applicant alleges that it would not have been obvious to one having ordinary skill in the art at the time of the invention would not have been motivated to adjust the particle size of the granulated flavor disclosed in the Benczedi reference since Benczedi does not disclose the claimed particle size. However, as stated in the prior action, discovery of an optimum value of a result effective variable in a known process is ordinarily within the skill of the art. In the instant case, the particle size can be adjusted in order to adjust the solubility, packing density and hardness of the granulated flavor. See In re Boesch, 617 F.2d 272, 276, 205 USPQ 215, 219 (CCPA 1980). No evidence is provided by applicant to point out that this is not possible, other than a statement that Benczedi does not explicitly disclose the claimed particle size, which is acknowledged in the first office action. Further it is noted that the Benczedi reference discloses a granulated flavor with a diameter of 0.7mm

(example 1) and that the length of the particles is adjustable (0051-0053). Selecting a narrow range from within a somewhat broader range disclosed in a prior art reference is no less obvious than identifying a range that simply overlaps a disclosed range;

> The normal desire of scientists or artisans to improve upon what is already generally known provides the motivation to determine where in a disclosed set of ranges is the optimum combination of values. In re Peterson 65 USPQ2d 1379 (CAFC 2003)

18. Applicant also argues that their invention has a partially melted plated matter as a step in the production of the granular flavor. However, applicants claims are drawn to a product, specifically, *"A granulated flavor for use in foods and beverages…"*, which is also disclosed by Benczedi. Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. **If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process.**" *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985) Further, "although produced by a different process, the burden shifts to applicant to come forward with evidence establishing an unobvious *difference between the claimed* ***product*** *and the prior art* ***product***", *In re Marosi*, 710 F.2d 798, 802, 218 USPQ 289, 292 (Fed. Cir.1983). See MPEP 2113.

Conclusion

19. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ANDREW KRAUSE whose telephone number is (571)270-7094. The examiner can normally be reached on 7:30-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Callie Shosho can be reached on (571)272-1123. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/ANDREW KRAUSE/
Examiner, Art Unit 1794

/Callie E. Shosho/
Supervisory Patent Examiner, Art Unit 1794